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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,147	02/28/2002	James E. King	5681-04202	3470

7590 03/29/2006

B. Noel Kivlin
Conley, Rose, & Tayon, P.C.
P.O. Box 398
Austin, TX 78767

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/086,147	Applicant(s) KING ET AL.	
	Examiner Matthew Heneghan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 40-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 and 40-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In response to the previous office action, Applicant has amended claims 3, 17, 29-31, and 43; cancelled claims 38 and 39; and added claims 44 and 45. Claims 1-37 and 40-45 have been examined.

Drawings

2. The drawings were received on 30 September 2002. These drawings are not acceptable.

3. A set of replacement drawings intended to address the previous stated drawing objections (see Remarks, filed 9 January 2006, p.3) was not found in the file wrapper.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "85" has been used to designate both a lead line in figures 5 and 6 and "Save Smart Card Address" in figure 7.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: item 85 as portrayed in figures 5 and 6.

6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claim 29 is objected to because of the following informalities: it is not clear what the transitional phrase in the claim is. It is being presumed that the limitations are being recited in an open-ended manner, beginning after the phrase "being operable to." Appropriate correction is required.

8. Claim 43 is objected to because of the following informalities: it is not clear what the transitional phrase in the claim is. It is being presumed that the limitations are being recited in an open-ended manner, beginning after the phrase " wherein." Appropriate correction is required.

Claim Rejections - 35 USC § 101

9. In view of Applicant's amendments, all previous rejections under 35 U.S.C. 101 are withdrawn.

Terminal Disclaimer

10. The terminal disclaimer filed on 9 January 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 09/930,384 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

11. In view of the filing of a terminal disclaimer, all previous rejections over the doctrine of double patenting are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1, 2, 5-7, 12-14, 17, 18, 22, 25, 26, 29, 30, 34, 37, and 40-45 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,260,111 to Craig et al.

As per claims 1, 5, 14, 29, and 42, Craig discloses a system having a smart card that is used for access by a network computer. The Smart card includes storage for various data, and the controlling of access through the storing of protected information only via the smart card's CPU; user information (the network identity) and other

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configuration are stored therein (see column 6, lines 38-52). The smartcard interfaces with a network computer using memory (see column 5, lines 51-67).

As per claim 2, the user preferences and power management information constitute software configuration information (see also column 7, lines 36-39).

As per claims 6 and 7, keys may also be stored in the smart card's secure area (see column 7, lines 12-15).

As per claim 12, RAM is used for memory (see column 5, line 62).

Regarding claim 13, the smart card's CPU is a programmed microcontroller.

As per claims 17, 22, and 34, the network computer has a smart card port (see column 5, line 58) for reading the smart card.

As per claims 18 and 30, the network computer may write parameters to the smartcard (see column 8, lines 46-48).

Regarding claims 25, 26, 37, 40, 41, and 43, a smart card port inherently uses a microprocessor for I/O (the service processor).

As per claims 44 and 45, Craig discloses the storing of user configuration parameters, such as those relating to power conservation, on the smart card according to the current operating conditions (see column 8, lines 25-48).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3, 4, 9, 19, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,111 to Craig et al. as applied to claims 1, 5, 18, and 30 above, and further in view of U.S. Patent No. 6,108,789 to Dancs et al.

Craig states that information in the smart card is stored in memory, but does not disclose the format for saving the information thereon.

Dancs discloses a smart card for internet access where the configuration information is saved in one or more files, and suggests that allows data to be stored in regions of different size, and some sizes are more efficient than others (see column 17, lines 20-57).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Craig by organizing the data on the smart card into files of varying sizes, as some sizes are more efficient than others.

14. Claims 8, 10, 11, 20, 21, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,111 to Craig et al. as applied to claims 5, 6, 17, and 29 above, and further in view of U.S. Patent No. 5,809,140 to Rubin et al.

Though Craig discloses the use of keys for retrieving information on the smartcard, Craig does not disclose the establishment of a session key for such retrievals.

Rubin discloses a session key establishment system for smart cards wherein a first key is sent, and a session key, derived from that input is established via a negotiating protocol (see column 7, lines 33-58). Rubin further discloses that this spares the need to store long-term secret keys (see column 3, lines 7-16).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Craig by employing the session key creation protocol disclosed by Rubin for enabling secure data transfers, as this spares the need to store long-term secret keys.

15. Claims 15, 23, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,111 to Craig et al. as applied to claims 1, 17, and 29 above, and further in view of Japan Patent Publication No. 07-058749 to Takiyasu et al.

Craig does not state where the MAC address is to be stored.

Takiyasu discloses the storing of the MAC address on the IC card, and suggests that this allows the card to be used for access on different terminals, such as a radio vs. wired terminal (see abstract).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a MAC address from the IC card, as disclosed by Takiyasu, as this allows the card to be used for access on different terminals.

16. Claims 16, 24, 27, 28, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,260,111 to Craig et al. as applied to claim 1, 17, and 29 above, and further in view of U.S. Patent No. 6,654,797 to Kamper.

Craig does not suggest the use of the smart-card in rack-mounted servers, or state how configuration on the smart-card is to be incorporated into the server upon boot-up.

Kamper discloses the use of smartcards in thin server configuration upon boot-up (see column 3, line 56 to column 4, line 19), and suggests that this allows for configuration without encountering the problems of locating, connecting, and securing the thin server (see column 1, lines 62-67). It is also noted that thin servers are rack-mountable (see column 1, lines 34-36).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use smartcards for thin server configuration upon boot-up, as this allows for configuration without encountering the problems of locating, connecting, and securing the thin server.

Response to Arguments

17. Applicant's arguments filed 9 January 2006 have been fully considered but they are not persuasive.

Regarding Applicant's argument that Craig does not disclose a portable storage device having network identity and configuration information, the user identification is

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sufficient to establish an identity on a network and the additional information (i.e. the user preferences and power management information) is configuration information.

Regarding Applicant's argument that Craig does not disclose an "access controller," it is noted that claim terms are given their broadest reasonable meaning in light of the specification. Applicant's specification states an access controller may be a smart card (see p.6, lines 14-16). It is reasonable to define an "access controller" in this context as being something that governs network access, as is the case in Craig's invention.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques, can be reached at (571) 272-6962.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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March 20, 2006

Jacques R. Loeis
JACQUES H. LOEIS
PRIMARY EXAMINER